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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,160	09/26/2001	John A. M. Cameron	WEAT/0150	9581

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EXAMINER	
HALFORD, BRIAN D	
ART UNIT	PAPER NUMBER
3672	

DATE MAILED: 01/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/964,160	CAMERON, JOHN A. M.	
	Examiner	Art Unit	
	Brian D Halford	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 September 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 September 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *1* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. Claim 8 is objected to because of the following informalities: the language employed in line 2 is grammatically awkward and nonplussing. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Ramos *et al.* Ramos *et al.* disclose a cable for connection to permanent downhole sensors. As mentioned in lines 47-53 of Column 1 a resilient sheath or housing surrounds the cable. The deformable sheath or housing may be fabricated from resilient materials, such as thermoset plastic or nitrile rubber, to circumvent cable breakage. Though not specifically disclosed, it is noted that metal is a resilient material and is capable of deformation. Ramos *et al.* disclose in lines 48-55 of Column 5 a crescent-shaped cable

housing for connecting cable to downhole sensors. Depicted lucidly in Figure 4, the cable (96) and sheath are enveloped and supplemented by moulded wings or housing (100, 102); moreover, the resultant geometry of the wings and sheath, or housing (100, 102), is substantially identical to that claimed by Applicant.

It is noted by the Examiner that the preambulatory language has not been given weight; specifically, the preamble of Claim 1 merely recites intended use. The body of Claim 1 fully sets forth all of the limitations of the claimed invention; subsequently, the preamble is not considered a limitation and is of no significance to claim construction. See MPEP § 2111.02.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castano-Mears *et al.* in view of Ramos *et al.* Castano-Mears *et al.* disclose a downhole expandable well screen that expands to substantially contact the wall of the wellbore. Furthermore, as stated in lines 19-25 of Column 1, the expandable well screen finds employment with productive, relatively unconsolidated downhole formations. As shown in Figures 15-18 and discussed in lines 8-40 of Column 11, the expandable well screen (166) contains expandable metal tubular ribs or housings (172) that are utilized to

convey myriad types of instrumentation lines. Lines 36-40 of the aforementioned column clearly state that any type of line may be inserted through the hollow ribs or housings (172). Figure 18 lucidly depicts the hollow rib or housing (172) containing a hydraulic or chemical injection line (176), an electrical line (178) and a fiber optic line (180). However, Castano-Mears *et al.* disclose in lines 41-45 that the ribs or housings (172) may collapse under excessive expansion force. Ergo, it may be preferable to locate the housing on the exterior of the screen or to provide a more robust housing. Castano-Mears *et al.* do not disclose, however, a crescent-shaped housing wherein the housing is placed between the expandable well screen and the wellbore. Ramos *et al.* disclose a crescent-shaped housing for instrumentation lines as previously discussed. Ramos *et al.* state in lines 41-46 of Column 5 that a crescent shape permits a close fit between the housing and the casing wall thereby eliminating gaps; furthermore, Ramos *et al.* intimate in line 42 of the aforementioned column that an inner concave surface (92) supplements the close fit. Ramos *et al.* further disclose that a tight fit avoids complications in the annulus during gravel packing procedures. Therefore, it would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to remove the ribs of Castano-Mears *et al.* and to add the robust crescent-shaped housing of Ramos *et al.* to the exterior of expandable well screen of Castano-Mears *et al.* for the purpose of ensuring a close fit, thereby eliminating the flow of fluids in the annulus (*i.e.* avoiding complications when conducting gravel packing operations), when the well screen is expanded and to ensure the integrity of the instrumentation lines if the well screen becomes damaged.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10-13, 15-16 and 18 of copending Application No. 09/964034. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structure and geometry of the encapsulation in the instant invention is clearly and lucidly delineated in Claims 1 and 10 of copending Application No. 09/964034; moreover, Claims 1 and 10 are simply more narrow than the broad Claim 1 of copending Application No. 09/964130. Furthermore, the encapsulation of the instant invention finds employment in a fashion tantamount to the encapsulation of copending Application No. 09/064030. Specifically, the encapsulation resides between an expandable well screen and the wellbore and additionally serves as a housing for instrumentation lines.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian D Halford whose telephone number is (703) 306-0556. The examiner can normally be reached on M-F 8:30-6:00; alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1020.

David Bagnell
Supervisory Patent Examiner
Art Unit 3672

BDH BDH
January 21, 2003

William Neuder
Primary Examiner